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JUN 04 2007

In re Application of:

Victor, Bart, et al.

Serial No. 09/772,810

Filed: January 30, 2001

Docket: 3977-8

Title:

METHOD AND MATERIALS FOR  
ENCOURAGING CREATIVE  
THINKING, PLANNING OR  
DECISION MAKING

DECISION ON PETITION  
UNDER 37 CFR § 1.181

This is a decision on the petition filed on October 16, 2006 requesting the Requirement for Information under 37 CFR § 1.105 in the Office action mailed April 12, 2006 be vacated and requesting that the Notice of Non-Compliant Amendment (the Notice) mailed August 01, 2006 be vacated in view of the vacating of the Requirement for Information. Alternatively, the petition requests, essentially, that the Notice be modified giving applicants one month to properly respond to the Notice with extendable periods, or alternatively, a new Office action should be remailed, restarting applicants' shortened statutory period.

The petition is dismissed.

Background

After an appeal brief was filed June 27, 2005, based on a Final Rejection mailed October 21, 2003, additional prior art in the form of publications came to the examiner's attention. The examiner newly rejected claims in an Office action mailed April 12, 2006 as anticipated by an article in The Technology Teacher entitled "TECHNOTOWN - A School- Wide Design Technology Project" (Technotown) at pages 39-43 dated September, 1994. (The examiner also requests applicants attention be directed to pages 13-15 in the same publication). The examiner points out in discussing Technotown that it is clear from the article that a Lego representative was present and based on this Lego should be aware of this reference. The examiner believes the reference to be sufficiently relevant to the examination that the 37 CFR § 1.105 requirement was made part of the Office action requiring applicants to submit all relevant information similar in nature to the Technotown reference.

Applicants submitted a response filed July 12, 2006 in which applicants argue the merits of the rejection and assert that the Requirement for Information is misdirected. The examiner mailed the Notice of Non-Compliant Amendment (August 01, 2006), informing applicants that their time continues to run from the mailing of the Office action mailed April 12, 2006. Applicants followed with the present petition under review.

### Discussion and Decision

It would appear from the omission of any denial in applicants' response to the Office action, that at least the applied publication in the Office action has been known by at least one assignee as asserted by the examiner. The examiner believes the publication sufficiently pertinent as a reference that the Requirement for Information for other related references or publications has been made. That applicants argue that the applied publication is not relevant is not the issue. Unless information becomes known to the contrary, it is assumed that applicants did not cite the publication based upon the belief it is not relevant for citation as part of their 37 CFR § 1.56 obligations or else inadvertently omitted citing it. Nevertheless, the purpose of 37 CFR § 1.105 is to go beyond 37 CFR 1.56. MPEP 704.11 states "[T]he purpose of 37 CFR § 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information."

From a recent Federal Circuit decision (*Star Fruits S.N.C. v. United States*, 73 USPQ2d 1409 (Fed. Cir. 2005)):

Scope of information that may be required from applicant by patent examiner pursuant to 37 C.F.R. §1.105 encompasses information relevant to patent examination either procedurally or substantively, and includes zone of information beyond that defined by 37 C.F.R. §1.56 as material to patentability, and beyond that which is directly useful to support rejection or conclusively decide issue of patentability, since Section 1.105(a)(1) states that PTO may "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter"[] *Star Fruits S.N.C. v. United States*, 73 USPQ2d 1409 (Fed. Cir. 2005).

Duty of candor embodied in 37 C.F.R. §1.56 does not give patent applicant power to refuse requirement for information under 37 C.F.R. §1.105, since neither regulation states that response to such requirement may be limited, at applicant's discretion, to whatever applicant believes it might be affirmatively required to submit under Section 1.56, since language in Section 1.105(a)(1), which permits PTO to "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter," expressly states that PTO, not applicant, controls scope of requirement for information, and since scope of information that may be required under Section 1.105 is broader than information that applicant is duty bound to provide under Section 1.56. *Star Fruits S.N.C. v. United States*, 73 USPQ2d 1409 (Fed. Cir. 2005).

United States Patent and Trademark Office can use requirement for information under 37 C.F.R. §1.105 to compel disclosure of information that patent examiner deems pertinent to patentability,

even if applicant disagrees with examiner concerning significance of information to ultimate question of whether application discloses patentable subject matter, since PTO is clearly entitled to use Section 1.105 to seek information that may support rejection, and since examiner is charged with duty of deciding whether patent should issue from application, and so long as examiner's request for information is not arbitrary or capricious, applicant cannot impede examiner's performance of that duty by refusing to comply with information requirement that proceeds from examiner's view of scope of law to be applied to application. *Star Fruits S.N.C. v. United States*, 73 USPQ2d 1409 (Fed. Cir. 2005).

In view of the above, the Requirement for Information is proper and will not be vacated or in any way modified.

As to vacating or amending the Notice of Non-Compliant Amendment, it is noted that 37 CFR § 1.105(c) states that a reply, or failure to reply, to a requirement for information will be governed by §§ 1.135 and 1.136. It does not appear that applicants made a *bona fide* attempt to respond to the Requirement for Information and merely failed in some part to comply. Instead, applicants explicitly refused to comply by stating the Requirement for Information is "misdirected and...traversed." Petitioner is apparently of the belief that the examiner must still provide the extendable one month period because the Notice of Non-Compliant Amendment fails to provide what the examiner did on the pre-printed except in the situation where the non-compliant amendment is an after-final or an amendment filed after allowance. However, the examiner and applicants are not governed by the propriety of the form used setting forth every situation encountered but by court precedent, statutes, the governing regulations, and the M.P.E.P. The examiner properly addressed the time applicants have remaining in the attachment to the form. Accordingly, the Notice of Non-Compliant Amendment will not be vacated or modified.

A new Office action restarting the shortened statutory period, as requested by petitioner as another alternative, will not occur. The examiner's Office action and the Notice of Non-Compliant Amendment are seen as proper. These examiner's actions that applicants are presently required to respond to are not seen as either arbitrary or capricious or containing error that requires that a new Office action be mailed restarting the shortened statutory period.

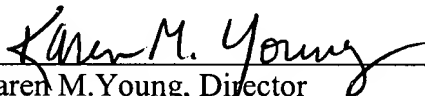
#### Summary

The Requirement for Information set forth within the Office action mailed April 12, 2006, and the Notice of Non-Compliant Amendment mailed April 12, 2006 stating that applicants' response time continues running, are proper and will not be vacated or modified. In view that they are proper, a new Office action providing a new, shortened statutory period will not occur.

Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. Petitioner is reminded that the mere filing of the request will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. See 37 CFR § 1.181(f).

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

  
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Karen M. Young, Director  
Technology Center 3700